

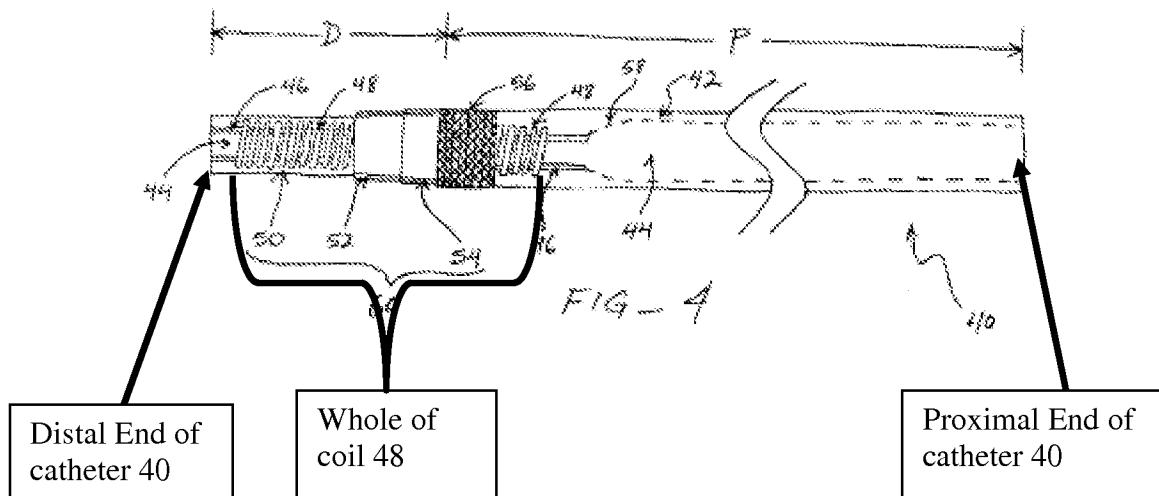
REMARKS

Applicant respectfully requests reconsideration of the present application. At the time the Examiner mailed the Final Office Action claims 28-35, 37-44 and 55-58 were pending. By way of the present response, Applicant has amended claims 29, 31, 39 and 56 in order to more particularly point out and distinctly claim the subject matter which Applicant regards as the invention. No claims have been canceled. New claim 59 has been added. As such, claims 28-35, 37-44 and 55-59 are now pending. No new matter has been added.

Drawings Objections

The examiner has objected to Figure 1 for not including the legend —Prior Art—. Appropriate correction has been made.

The Examiner has objected the drawings under 37 CFR 1.83(a) as allegedly not showing “the whole of the coil disposed nearer the distal end”. The Examiner’s attention is directed toward FIG.4 of the original application, reproduced below. As illustrated below, the whole of coil 48 is indeed disposed nearer the distal end of the catheter 40 than the proximal end of the catheter 40.



Accordingly, Applicant respectfully submits that the drawings are in compliance with 37 CFR 1.83(a) and requests the withdrawal of the objections.

Claim Rejections - 35 U.S.C. § 112

The Examiner has rejected claims 28-35, 37-44 and 55-58 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. As described above, the feature of “the whole of the coil disposed nearer the distal end” is adequately supported by FIG. 4.

The Examiner states on pages 3-4 of the Office Action that the original disclosure and FIG. 4 disclose coil 48 extending through both the distal and proximal ends. This is not correct. As illustrated in FIG. 4, the coil 48 extends through both the distal portion D and proximal portion P. FIG. 4 does not illustrate the coil 48 extending through both the distal and proximal ends.

The Examiner has rejected claims 28-35, 37-44 and 55-58 under 35 U.S.C. § 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In view of the Examiner’s comments, it is Applicant’s understanding that the Examiner is reading the claim terms distal/proximal “end” and distal/proximal “portion” synonymously, which is inconsistent with the use of the terms in the original application and figures.

Accordingly, Applicant respectfully submits that claims 28-35, 37-44 and 55-58 comply with the formalities of 35 U.S.C. § 112, first and second paragraphs, and requests the withdrawal of the rejections.

Claim Rejections - 35 U.S.C. § 103

The Examiner has rejected claims 28-35, 37-44 and 56-58 under 35 U.S.C. § 103(a) as being unpatentable over *Saadat et al.*, (U.S. Patent No. 5,935,137) in view of *Berhow et al.* (U.S. Publication No. 2003/0135198). The Examiner has rejected claim 55 under 35 U.S.C. § 103(a) as being unpatentable over *Saadat et al.*, in view of *Berhow et al.* as applied to Claim 28, and further in view of *Shepherd et al.* (U.S. Patent No. 3,566,874).

Applicant teaches and claims in amended independent claim 28 a system for delivering a contraceptive device within a fallopian tube, the system comprising, *inter alia*, “wherein the distal portion has varying degrees of flexibility determined by constraining the coil within an outer layer of varying thickness or durometer rating along the length of the coil extending along the distal portion.” Support for the amendment can be found in at least paragraph [0048] and FIG. 4 of the application.

It is Applicant’s understanding that *Saadat et al.* discloses a tubular fallopian sterilization device. *Saadat et al.* does not disclose or suggest constraining a coil within an outer layer of varying thickness or durometer rating along the length of the coil extending along a distal portion of the catheter as is taught and claimed by Applicant in independent claim 28.

It is Applicant’s understanding that *Berhow et al.* discloses in FIG. 1. a medical catheter (10) having a reinforcing member (16) which may be braided. See paragraph [0049]. As acknowledged by the Examiner, the reinforcing member (16) extends along the length of the catheter from the distal end (13) to the proximal end (12). Thus, the reinforcing member (16) is not disposed nearer the distal end of the catheter body than the proximal end of the catheter body.

As described in paragraph [0051] “the reinforcing member (16) may be terminated proximal to the distal end of the catheter shaft, and a spiral reinforcing member (a helical coil of flat or round material) can be manually slid into its place.” This is additionally illustrated in FIG. 5, where a coiled portion (46a) is slid into place. As described with regard to FIG. 5, the distal segment 40A does not have a varying hardness or thickness along the length of the coiled portion (46a). Therefore, the coiled portion (46a) is not within an outer layer of varying thickness or durometer rating along the length of the coil extending along a distal portion of the catheter as is taught and claimed by Applicant in independent claim 28

It is Applicant's understanding that *Shepherd et al.* discloses catheters provided with a coating of a hydrophilic acrylate or methacrylate polymer. Applicant respectfully submits that *Shepherd et al.* fails to remedy the deficiencies of *Saadat et al.* and *Berhow et al.* discussed above.

Claims 29-35, 37-44 and 56-58 depend directly upon independent claim 28 and are patentable for at least the same reasons. In view of the foregoing amendment and remarks, Applicant respectfully submits that the pending claims are in condition for allowance and requests the withdrawal of the rejections of claims 28-35, 37-44 and 56-58 under 35 U.S.C. § 103(a).

With regard to dependent claim 57, the Examiner states that "Berhow teaches a tapered region (32) and a lumen (15) that extends throughout the catheter (10). (Paragraph 0038)." Applicant respectfully points out that the tapered region (32) is in the distal portion, not the proximal portion of the catheter. Therefore, *Berhow et al.* does not disclose or suggest "the lumen includes a tapered region where the lumen extends through the proximal portion" as is taught and claimed by Applicant in claim 57. Accordingly, Applicant respectfully requests the withdrawal of the rejection of claim 57 under 35 U.S.C. § 103(a) in addition to the reasons provided for independent claim 28.

New Claims

New claim 59 requires, *inter alia*, "wherein the distal portion has varying degrees of flexibility determined by constraining the coil within an outer layer having varying thickness along the length of the coil extending along the distal portion." It is Applicant's understanding these features are not taught by the references of record.

In view of the foregoing amendments and remarks, Applicant respectfully submits that the pending claims are in condition for allowance.

Please charge any shortages and credit any overages to Deposit Account No. 02-2666.

Any necessary extension of time for response not already requested is hereby requested. Please charge any corresponding fee to Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: March 29, 2010

/Jacob Aikin/

Jacob T. Aikin

Reg. No. 62,787

1279 Oakmead Parkway
Sunnyvale, CA 94085-4040
(408) 720-8300